



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Document No. 6

Michael J. Mallie
Blakely, Sokoloff, Taylor & Zafman LLP
12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025-1026

COPY MAILED

MAY 02 2002

In re Application of :
Kevin X. Zhang :
Application No. 09/532,411 :
Filed: March 22, 2000 :
Attorney Docket No. 42390.P8265 :

OFFICE OF PETITIONS

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(a) filed February 21, 2002, to revive the above-mentioned application. Petitioner is advised that the instant petition will be treated as petition filed under 37 CFR 1.137(a) and 37 CFR 1.181(a) to withdraw the holding of abandonment.

The petition under 37 CFR 1.137(a) is **dismissed**.

The petition under 37 CFR 1.181(a) to withdraw the holding of abandonment is also **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition" under 37 CFR 1.181(a) and/or 37 CFR 1.137(a).

This application became abandoned for failure to file a timely reply to the "Notice of Missing Parts of Nonprovisional Application" (the "Notice") mailed June 6, 2000. The Notice set forth an extendable period for reply of two months from its mailing date. Accordingly, this application became abandoned on August 7, 2000. A Notice of Abandonment was mailed January 7, 2002. In the instant petition, petitioner maintains that the Notice was never received and, therefore, no reply could be submitted.

TREATMENT UNDER 37 CFR 1.137(a)

A grantable petition under 37 CFR 1.137(a)¹ must be accompanied by: (1) the required reply,² unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the

¹ As amended effective December 1, 1997. See Changes to Patent Practice and Procedure; Final Rule Notice 62 Fed. Reg. 53131, 53194-95 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 119-20 (October 21, 1997).

² In a Nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer required by 37 CFR 1.137(c).

The instant petition lacks item (3) above.

As to item (3), the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.137(a).

The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.

“In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner’s interpretation of those provisions is entitled to considerable deference.”³

“[T]he Commissioner’s discretion cannot remain wholly uncontrolled, if the facts **clearly** demonstrate that the applicant’s delay in prosecuting the application was unavoidable, and that the Commissioner’s adverse determination lacked **any** basis in reason or common sense.”⁴

“The court’s review of a Commissioner’s decision is ‘limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.’”⁵

“The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgement for that of the agency.”⁶

The standard

³Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff’d without opinion (Rule 36), 937 F.2d 623 (Fed. Cir. 1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg 849 F.2d 1422, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) (“an agency’ interpretation of a statute it administers is entitled to deference”); see also Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) (“if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency’s answer is based on a permissible construction of the statute.”)

⁴Commissariat A L’Energie Atomique et al. v. Watson, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

⁵Haines v. Quigg, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct. 1241, 1244 (1973) (citing 5 U.S.C. §706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir. 1982)).

⁶Ray v. Lehman, 55 F.3d 606, 608, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citing Motor Vehicles Mfrs. Ass’n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."⁷ The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"⁸ Nonawareness of a PTO rule will not constitute unavoidable delay.⁹

Application of the standard to the current facts and circumstances

In the instant petition, petitioner maintains that the circumstances leading to the abandonment of the application meet the aforementioned unavoidable standard and, therefore, petitioner qualifies for relief under 37 CFR 1.137(a). In support thereof, petitioner asserts that petitioner did not receive the Notice and provided a statement detailing petitioner's docketing procedures for incoming correspondence. Petitioner further asserts that delay was unavoidable because petitioner was not able to respond to the Notice because petitioner did not receive the Notice.

With regard to item (3) above, the aforementioned argument of petitioner in support of petitioner's belief that the above-cited application was unavoidably abandoned is not persuasive. The reasons petitioner's argument must necessarily fail are addressed below.

The application was filed on March 22, 2000. A "Notice to File Missing Parts of Nonprovisional Application" was mailed on June 6, 2000, to the correspondence address of record, which is the same address that is cited on the instant petition. The record reflects that on September 4, 2001, Ms. Linda Hallman of the United States Patent and Trademark Office, attempted to contact Mr. Michael Mallie, an attorney of record for the above-cited application, regarding the impending abandonment, but Mr. Mallie was not available. There does not appear that there was any further communication between the Office and petitioner until January 7, 2002, when the Notice of Abandonment was mailed. The instant petition was then filed on February 21, 2002 (certificate of mailing dated February 6, 2002.) Though petitioner argues that the "Notice to File Missing Parts of Nonprovisional Application" was not received, and even if that were to be accepted as fact, petitioner does not indicate why no inquiry was made relative to the application's status during the eleven month period that passed between the application's filing and the date the petition was filed. It may be reasoned that the exercise of prudence in relation to this most important business would require that petitioner make some inquiry into the status of the application given the extended period of time that passed between the filing of the application and the date the Notice of Abandonment was sent. At this juncture, the conclusion cannot be reached that the delay was unavoidable

⁷Id.

⁸See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

⁹See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

as petitioner has not demonstrated that petitioner acted prudently relative to prosecution of the application.

Petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by the required reply (already submitted), the required petition fee (\$1,280.00 for a large entity and \$640.00 for a verified small entity), and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. A copy of a blank petition form PTO/SB/64 is enclosed for petitioner's convenience.

TREATMENT UNDER 37 CFR 1.181(a)

Section 711.03(c)(II) of the *Manual of Patent Examining Procedure* ("MPEP") provides that in order to establish non-receipt of an Office communication so as to prove that the imposition of a holding of abandonment is improper, petitioner must: 1) provide a statement to the Office indicating that the Office action was not received by petitioner; 2) include in the statement an attestation to the fact that a review of the file jacket and docket records maintained by petitioner indicates that the Office action was not received; and 3) provide a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed. The aforementioned section of the MPEP also indicates that all of petitioner's docket records beginning from the mail date of the non-received Office action through the entire period set for reply (which, in this case, was three-months) should be provided as documentary evidence of non-receipt of the Office action.

Although petitioner provided a statement indicating that the Office action was not received, petitioner did not provide a copy of the relevant docket records as is specifically required to satisfactorily establish that an Office communication was not received. Any renewed petition filed must include a copy of the docket records along with any other documentation to support petitioner's contention that the "Notice of Missing parts of Nonprovisional Application" was never received.

The "Declaration and Power of Attorney" filed February 21, 2002, is noted and made of record.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By facsimile: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202

Telephone inquiries concerning this decision should be directed to Kenya A. McLaughlin, Petitions Attorney, at (703) 305-0010.

B M Flanagan
Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

Enclosure: PTO/SB/64

Petition Act Stat